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09/898,707	07/03/2001	Thomas Zickell	NEI-010XX	2439

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EXAMINER
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AUGHENBAUGH, WALTER

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/898,707

Applicant(s)

ZICKELL, THOMAS

Examiner

Walter B. Aughenbaugh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 21-44 is/are pending in the application.
- 4a) Of the above claim(s) 32-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Acknowledgement of Applicant's Amendments***

1. New claims 21-44 presented in the Amendment filed September 27, 2005 (Amdt. F) have been received and considered by Examiner.
2. Applicant's cancellation of claims 1-9 and 11-20 in Amdt. F has been acknowledged by Examiner.

### ***Election/Restrictions***

3. Newly submitted claims 32-44 are directed to inventions that are independent or distinct from the invention originally claimed for the following reasons:

Inventions II (claims 32-43) and I (claims 21-31) are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination requires that the granules contact an outer surface of the first layer whereas the subcombination requires that the granules contact an outer surface of the second layer. The subcombination has separate utility such as flooring.

Inventions III (claim 44) and I (claims 21-31) are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the

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intermediate product is deemed to be useful as flooring and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Inventions II (claims 32-43) and III (claim 44) are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the subcombination requires that the second asphalt composition only contacts a first portion of the upper surface of the substrate, whereas the combination does not include this limitation. The subcombination has separate utility such as flooring.

4. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 32-44 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***WITHDRAWN REJECTIONS***

5. The 35 U.S.C. 112 rejections of claims 1 and 14 that were repeated in paragraphs 3 and 4 of the Advisory Action mailed September 12, 2005 have been withdrawn due to Applicant's cancellation of claims 1 and 14 in Amdt. F.

6. The 35 U.S.C. 103 rejection of claims 1-9 and 11-15 that was repeated in paragraph 5 of the Advisory Action mailed September 12, 2005 has been withdrawn due to Applicant's cancellation of claims 1-9 and 11-15 in Amdt. F.

***NEW REJECTIONS***

***Claim Rejections - 35 USC § 112***

7. Claims 21, 22 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 21, that which the first layer contacts cannot be ascertained: claim 21 recites the limitation "said second region" in the fifth and seventh lines of the claim; there is insufficient antecedent basis for this limitation in the claim. It cannot be ascertained whether or not Applicant intends the "second region" recited in the eighth line of the claim to be the same component as the component Applicant refers to as "said second region" in the fifth and seventh lines of the claim: should "second region" in the eighth line of the claim be "third region"?

In regard to claim 22, since potentially two separate components are both called "second region" in claim 21, the component to which Applicant refers as the "second region" in claim 22 (third and fourth lines) cannot be ascertained.

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In regard to claim 30, text is missing between “said” and “includes” in the second line of the claim.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 21, 22, 24 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Simpson et al.

In regard to claim 21, Simpson et al. teach a rolled roofing material comprising a substrate saturated with a first asphalt composition (impregnated mat, item 92, col. 5, lines 34-62). Simpson et al. teach that the substrate includes a first region having a first layer of a second asphalt composition (coating, item 24, col. 3, lines 25-29 and col. 4, lines 36-39) contacting an upper surface of the substrate. Simpson et al. teach that the first region includes a second layer of an adhesive composition (adhesive, item 94, col. 5, lines 48-62) contacting a lower surface of the substrate. Simpson et al. teach that the substrate includes a region disposed along at least a first edge of the substrate (edge of substrate 92, Fig. 9) where the second region has an upper and a lower surface (the upper portion of the edge of substrate 92 and the lower portion of the edge of substrate 92) that are both free of both the first and second asphalt compositions. Simpson et al. teach that granules contact an outer surface of the second layer (adhesive, item 94) because the second layer contacts substrate 92, substrate 92 is impregnated with asphalt, and asphalt comprises bitumen (col. 4, lines 35-37). Simpson et al. teach that the substrate includes a release

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backing (release paper, item 96, col. 5, lines 48-62) disposed over a bottom surface of the second layer (adhesive, item 94).

In regard to claim 22, Simpson et al. teach that the rolled covering material further includes a parting agent covering (the silicon compound release coating, col. 3, lines 32-35) substantially covering the lower surface of the substrate wherein the parting agent necessarily resists adhering to the upper surface of the substrate when the covering material is rolled since it is a release coating.

In regard to claim 24, Simpson et al. teach that the substrate includes non-woven polyester (col. 5, lines 48-50), which is a fibrous material.

In regard to claim 29, Simpson et al. teach that the adhesive composition includes a rubberized asphalt material (col. 6, lines 21-34; styrene-butadiene radial block polymer is a rubber).

***Claim Rejections - 35 USC § 103***

10. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson et al.

In regard to claim 30, Simpson et al. teach that the adhesive composition includes by weight 13% styrene-butadiene block polymer, 12% sand (filler), 7% oil and 63% bitumen (flux asphalt, col. 4, lines 35-39). Normally, it is to be expected that minor changes in the relative amounts of rubber, filler, oil and asphalt in an asphalt based adhesive would be an unpatentable modification. Under some circumstances, however, changes such as a change to the relative amounts of rubber, filler, oil and asphalt in an asphalt based adhesive may impart patentability to an article if the particular ranges claimed produce a new and unexpected result which is different

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in kind and not merely in degree from the results of the prior art. *In re Boesch and Slaney*, 205 USPQ 215 (CCPA 1980).

11. Claims 25-28 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson et al. in view of Kennepohl et al.

Simpson et al. teaches the material as discussed above.

In regard to claim 25, Simpson et al. fail to teach that the substrate is a fiberglass mat. Kennepohl et al., however, disclose a rolled roofing material comprising a substrate having upper and lower surfaces (backing, col. 1, line 39) where an asphalt composition saturates the substrate (col. 1, lines 38-48 and col. 3, line 65-col. 4, line 5). Kennepohl et al. teach that the substrate is a fiberglass mat (col. 8, line 66-col. 9, line 16). Therefore, one of ordinary skill in the art would have recognized to have replaced the non-woven polyester mat of Simpson et al. with the fiberglass mat of Kennepohl et al. since fiberglass mats are well known materials for use as an asphalt-saturated substrate for rolled roofing material as taught by Kennepohl et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have replaced the non-woven polyester mat of Simpson et al. with the fiberglass mat of Kennepohl et al. since fiberglass mats are well known materials for use as an asphalt-saturated substrate for rolled roofing material as taught by Kennepohl et al.

In regard to claim 26, Simpson et al. fail to explicitly teach that the first and second asphalt compositions are the same. Kennepohl et al., however, disclose that the asphalt composition that saturates the substrate is also coated on the upper surface of the substrate (col. 1, lines 38-48 and col. 3, line 65-col. 4, line 5). Therefore, one of ordinary skill in the art would have recognized to have used the same asphalt composition as both asphalts of Simpson et al.



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since it is well known to use the same asphalt composition that saturates the substrate as a coating on the upper surface of the substrate in roofing material as taught by Kennepohl et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the same asphalt composition as both asphalts of Simpson et al. since it is well known to use the same asphalt composition that saturates the substrate as a coating on the upper surface of the substrate in roofing material as taught by Kennepohl et al.

In regard to claim 27, Simpson et al. teach that the asphalt composition includes a mineral filler (silica sand, col. 4, lines 45-46). Simpson et al. fail to explicitly teach that the asphalt compositions include an oxidized asphalt, Kennepohl et al. teach that oxidized asphalt (col. 7, lines 36-55) with a mineral filler (col. 1, lines 20-48) is a notoriously well known noncombustible material for use as roofing. Therefore, one of ordinary skill in the art would have recognized to have oxidized the asphalt composition of Simpson et al. since oxidized asphalt is a well known noncombustible material for use as roofing as taught by Kennepohl et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have oxidized the asphalt composition of Simpson et al. since oxidized asphalt is a well known noncombustible material for use as roofing as taught by Kennepohl et al.

In regard to claim 28, Simpson et al. fail to teach that the mineral filler is limestone. Kennepohl et al. teach that the asphalt composition includes limestone as the mineral filler (col. 5, line 62-col. 6, line 3). Therefore, one of ordinary skill in the art would have recognized to have used limestone as a mineral filler in the asphalt of Simpson et al. since limestone is a well known filler for noncombustible material for use as roofing as taught by Kennepohl et al.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used limestone as a mineral filler in the asphalt of Simpson et al. since limestone is a well known filler for noncombustible material for use as roofing as taught by Kennepohl et al.

In regard to claim 31, while Kennepohl et al. and Simpson et al. fail to explicitly teach that the first asphalt composition and the adhesive composition each have a fuel content wherein the fuel content of the first asphalt composition is low enough such that the asphalt composition is fire resistant, Kennepohl et al. teach that the composite building material of Kennepohl et al. has superior fire retarding properties (col. 5, lines 62-64). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have adjusted the fuel content of the adhesive composition to determine the fuel content that yields the optimum fire resistance to achieve a fire resistant asphalt composition depending on the desired end user result, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art in the absence of unexpected results. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

12. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson et al. in view of Kennepohl et al. and in further view of McGroarty et al.

Simpson et al. and Kennepohl et al. teach the material as discussed above.

McGroarty et al. disclose a waterproofing sheet (item 10) that is especially valuable for use on roofs, having an edge portion (item 13, Fig. 1) that is left without the layers that are coextensive over the remainder of the sheet (excluding edge portion, item 13) so that the sheets can be lapped so that the sheets, when installed, provide a continuous impervious layer (col. 2,

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line 49-col. 3, line 11 and Fig. 1 and 2). Furthermore, McGroarty et al. teach that the decorative surface area (the membrane, item 10, Fig. 1, col. 4, lines 51-52) is wider than the surface area of the adhesive waterproofing layer (item 11, col. 4, lines 55-60) that corresponds to the adhesive surface area of Simpson et al. Therefore, one of ordinary skill in the art would have recognized to have coated the adhesive surface area of Simpson et al. such that the upper surface of the substrate of Simpson et al. is wider than the surface area of the parting agent covered surface area as taught by McGroarty et al. in order to enable strips of the covering material to be lapped together so that the sheets, when lapped together, provide a continuous impervious layer as taught by McGroarty et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have coated the adhesive surface area of Simpson et al. such that the upper surface of the substrate of Simpson et al. is wider than the surface area of the parting agent covered surface area as taught by McGroarty et al. in order to enable strips of the covering material to be lapped together so that the sheets, when lapped together, provide a continuous impervious layer as taught by McGroarty et al.

### ***Response to Arguments***

13. Applicant's arguments presented on pages 10-16 of Amdt. F are moot due to the withdrawal of the 35 U.S.C. 103 rejection of claims 1-9 and 11-15 in this Office Action.

### ***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is 571-272-

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1488. While the examiner sets his work schedule under the Increased Flexitime Policy, he can normally be reached on Monday-Friday from 8:45am to 5:15pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is to 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Walter B. Aughenbaugh

11/10/05

WBA

  
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1772

11/14/05